

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: E. Altmann

Art Unit: 1624

Examiner: V. Balasubramanian

APPLICATION NO: 10/525,658

FILED: August 23, 2005

FOR: HETEROARYL NITRILE DERIVATIVES

**MS: General**

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

**PETITION REGARDING PATENT TERM ADJUSTMENT UNDER C.F.R. §1.705(b)**

Sir:

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 713 days. This application is being filed with the payment of the issue fee, as required by 37 C.F.R. § 1.705 (b).

**I. Fee**

As required by 37 C.F.R. § 1.705(b)(1), this application is accompanied by a request to charge Deposit Account No. **50-4409** for \$ 200.00 to cover the required fee (as defined in 37 C.F.R. § 1.18(e)). Please charge any deficiencies or any additional fees due in response to this request to Deposit Account **50-4409**.

**II. Statement of the Facts Involved**

**A. Correct Patent Term Adjustment**

The Notice of Allowance, which was mailed on December 16, 2008, indicated a preliminary Patent Term Adjustment of 518 days.

Patentee has calculated an initial patent term adjustment of 713 days based on the following facts:

**Case Law**

In *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063 (D.D.C. 2008), the District Court of the District of Columbia addressed the United States Patent and Trademark Office (USPTO) interpretation of 35 U.S.C. § 154(b)(2). The Court granted summary judgment in favor of Wyeth, determining that the USPTO misconstrued the first sentence of 35 U.S.C. § 154(b)(2)(A), and as a result, improperly denied Wyeth a portion of patent term to which Wyeth was entitled under 35 U.S.C. § 154.

In the opinion, the Court stated that "the PTO's view is that any administrative delay under § 154(b)(1)(A) overlaps any 3-year maximum pendency delay under § 154(b)(1)(B): the applicant gets credit for 'A delay' or for 'B delay,' whichever is larger, but never A + B." However, Plaintiff Wyeth argued that the § 154(b)(1)(A) and § 154(b)(1)(B) period overlap only if they occur on the same calendar day or days. The Court determined that Wyeth's construction of § 154(b)(2)(B) was correct.

Simply put, the holding of the Court is that the excluded overlap recited in the first sentence of 35 U.S.C. § 154(b)(2)(A) only occurs if a 35 U.S.C. § 154(b)(2)(A) period and a 35 U.S.C. § 154(b)(2)(B) period run concurrently. As such, a patent holder is entitled to recoup the 35 U.S.C. § 154(b)(2)(A) period that falls outside of the 35 U.S.C. § 154(b)(2)(B) period in addition to the 35 U.S.C. § 154(b)(2)(B) period itself.

#### **Relevant Dates**

The above identified application has a 35 U.S.C. §371 filing date of August 23, 2005.

The first Office Action, which was a Restriction Requirement, was mailed on March 24, 2008, resulting in a PTO delay of 518 days beyond the 14 months provided by 35 U.S.C. §154(b).

A Response by Patentee was filed April 22, 2008, within the 3 months provided by 35 U.S.C. §154(b).

An Office Action was mailed June 24, 2008, within the 4 months provided by 35 U.S.C. §154(b).

A Response by Patentee was filed September 22, 2008, within the 3 months provided by 35 U.S.C. §154(b).

A Notice of Allowance was mailed December 16, 2008, within the 4 months provided by 35 U.S.C. §154(b).

The issue fee has been paid on March 6, 2009 in a paper accompanying the instant petition, within the 3 months provided by 35 U.S.C. §154(b).

Accordingly, the initial PTO adjustment based on delay under 35 U.S.C. § 154(b)(2)(A) is 518 days. The reduction in term adjustment due to applicant delay is 0 days, resulting in a patent term adjustment of 518 days under 35 U.S.C. § 154(b)(2)(A).

The initial 35 U.S.C. § 154(b)(2)(B) period for the instant application began on August 23, 2008 (three years after the filing date of August 23, 2005) and will end on the date of issuance. The initial 35 U.S.C. § 154(b)(2)(B) period running from August 23, 2008 until payment of the issue fee (March 6, 2009) is 195 days. The reduction in term adjustment due to applicant delay is 0 days, resulting in an initial patent term adjustment of 195 days under 35 U.S.C. § 154(b)(2)(B).

There was 0 days of PTO delay under 35 U.S.C. § 154(b)(2)(A) that occurred within the initial 35 U.S.C. § 154(b)(2)(B) period that should be excluded from the patent term adjustment calculation under the holding of *Wyeth v. Dudas*.

Accordingly, the sum of the 35 U.S.C. § 154(b)(2)(B) delay (195 days) and non-overlapping 35 U.S.C. § 154(b)(2)(A) delay (518 days) is 713 days.

The initial PTA printed on the Notice of Allowance is only 518 days, which the USPTO is presumed to have calculated using the method considered proper before the holding of *Wyeth v. Dudas*. Applicants therefore respectfully request reconsideration of the initial PTA calculation.

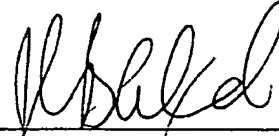
#### **B. Terminal Disclaimer**

The above-identified patent is not subject to a Terminal Disclaimer.

#### **C. Reasonable Efforts**

Any applicant delays under 37 C.F.R. § 1.704 are set forth above. There were no other circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John Alexander', written over a horizontal line.

John Alexander  
Attorney for Applicant  
Reg. No. 48,399

Novartis Institutes for BioMedical Research, Inc.  
220 Massachusetts Avenue  
Cambridge, MA 02139  
(617) 871-3105

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